Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte STEVEN WILLIAM ROTH

Appeal No. 2003-1614
Application No. 09/817,692

ON BRIEF

Before THOMAS, RUGGIERO, and BARRY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1-7, 10-13, 15, and 18-22. The appellant appeals therefrom under 35 U.S.C. § 134(a). We reverse.

BACKGROUND

The invention at issue on appeal arranges items displayed in a menu of a graphical user interface ("GUI") for a computer. A user employing a GUI can interact with a computer by pointing to menus of items. Menus may be "fixed content" or "variable content." While the items of a fixed content menu remain the same over time, the items of a variable content menu change over time. (Spec. at 2.)

According to the appellant, existing menuing mechanisms arrange menu items rigidly. Fixed content menus are never rearranged, no matter how often a user selects or ignores certain items. Variable content menus change only in strict sequence with the order of past selections such that only recent selections appear on the menu. (*Id.*)

In contrast, the appellant's invention "provides comprehensive menu arrangement control by providing several discrete, yet complementary, features." (*Id.* at 4.) "Automatic ranking" uses "heuristics" to control the order in which items such as uniform resource locators ("URLs") are arranged in a menu. Heuristics describe past use, e.g., frequency of selection, recency of selection, and time-of-day of selection. Using "manual control" a user can override an automatic ranking by placing a URL at a specific location (e.g., first), (Appeal Br. at 3), or to specify a time-of-day during which individual items are to appear near the top of the menu. (Spec. at 4.) Using a "smart load facility" the user can choose to have a web browser automatically load a selected web page after initialization or to have the web browser automatically load the web page that appears at the top of a list of URLs. (*Id.* at 5.)

A further understanding of the invention can be achieved by reading the following claims.

1. A computer system comprising:

a processor;

memory connected to said processor;

a web browser stored in said memory for execution on said processor, said web browser being used to present an initial web page to a user and then to present one or more subsequent web pages to said user, said web browser automatically selecting said initial web page from a plurality of web pages during initialization of said web browser and automatically presenting said initial web page to said user after said web browser has completed initializing, said plurality of web pages including historical web page selections by said user, said initial web page being determined via ranking control, said ranking control being selected from the group consisting of:

automatic ranking control; and

manual ranking control.

2. The computer system of claim 1 wherein said plurality of web pages make up an ordered list of web pages.

7. A computer system comprising:

a processor;

memory connected to said processor;

a web browser stored in said memory for execution on said processor; and

> a menu for presentation by said program, said menu having a Uniform Resource Locator (URL) list containing a plurality of URLs, at least some URLs in said list being arranged based at least in part upon time of day.

Claims 1-6 stand rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-5 of U.S. Patent No. 6,266,060 ("Roth"). Claims 7, 13, and 15 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,727,129 ("Barrett"). Claims 10-12 and 18-22 stand rejected under 35 U.S.C. § 103(a) as obvious over Barrett and Mark R. Brown ("Brown"), *Using Netscape 3* (1996).

OPINION

Our opinion addresses the rejections in the following order:

- double patenting rejection
- anticipation and obviousness rejections.

A. DOUBLE PATENTING REJECTION

Rather than reiterate the positions of the examiner or the appellant *in toto*, we address the point of contention therebetween. Observing that "as per claim 1 in the application 'said initial web page from a plurality of web pages'; and 'said plurality of web pages make up an ordered list of web pages' (claim 2)," (Final Rej. at 4), the examiner asserts, "an 'initial web page in the ordered list of web pages' is inherently

states [sic] that 'a first web page in a list of web pages'." (*Id.*) The appellant argues, "[c]laim 1 of U.S. Patent No. 6,226,060 calls for an 'initial web page *that is a first web page* in a list of web pages.' Claims 1-5 of the instant application do not include such a limitation. " (Appeal Br. at 5.)

"A double patenting rejection precludes one person from obtaining more than one valid patent for either (a) the 'same invention,' or (b) an 'obvious' modification of the same invention." *In re Longi*, 759 F.2d 887, 892, 225 USPQ 645, 648 (Fed. Cir.1985). "[T]he term 'same invention,' in this context means an invention drawn to identical subject matter." *Id.*, 225 USPQ at 648 (citing *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970)). "A good test, and probably the only objective test, for 'same invention,' is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention." *Vogel*, 422 F.2d at 441, 164 USPQ at 622.

Here, independent claim 1 of Roth recites in pertinent part the following limitations: "automatically selecting said initial web page from a list of web pages during initialization of said web browser . . . wherein said initial web page is a first web page in said list of web pages. . . ." Independent claims 2 and 5 of the patent recite similar

limitations. In summary, the independent claims of Roth require selecting a **first** web page from a list of web pages.

In contrast, claim 1 of the instant application recites in pertinent part the following limitations: "said web browser automatically selecting said initial web page from a plurality of web pages during initialization of said web browser. . . ." Claims 3 and 5 of the application recite similar limitations. Claim 2 of the application, which depends from claim 1, recites in pertinent part the following limitations: "said plurality of web pages make up an ordered list of web pages." Claims 4 and 6 of the application, which respectively depend from claims 3 and 5, recite similar limitations. In summary, although claims 1-6 of the application require selecting a web page from an ordered list of web pages, the claims do not require that selected web page be the first web page from the list. Because the claims of the application do not require that the web page selected be the first web page, we agree with the appellant that "a mechanism could very well literally infringe one of the rejected claims [of the application] without literally infringing [c]laim 1 of U.S. Patent No. 6,226,060. . . ." Therefore, we reverse the statutory double patenting rejection of claims 1-6.

Despite the impropriety of the statutory rejection, obviousness follows *ipso facto* from an anticipatory reference. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d

1440, 1446, 221 USPQ 385, 390 (Fed. Cir. 1984). "[A] disclosure that anticipates under Section 102 also renders the claim invalid under Section 103, for 'anticipation is the epitome of obviousness.'" *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983) (quoting *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982)). "[A]nticipation is a question of fact." *Hyatt*, 211 F.3d at 1371, 54 USPQ2d at 1667 (citing *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 814-15 (1869); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997)).

Here, because the claims of Roth appear to include all the limitations of claims 1-6 of the application, the former claims seem to anticipate the latter claims. The obviousness of claims 1-6 of the application, therefore, would likely follow *ipso facto* from the anticipation. In an *ex parte* appeal, however, "the Board is basically a board of review — we review . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (Bd.Pat.App. & Int. 2001). Having no double patenting rejection based on obviousness before us to review, we leave the issue to the examiner and the appellant.[1]

---

[1]A terminal disclaimer may be used to obviate a double patenting rejection based on obviousness. 37 C.F.R. § 1.130(b) (2003). For his part, the "[a]ppellant would certainly consider the filing of an appropriate terminal disclaimer should such be ultimately required by the Examiner." (Appeal Br. at 5.)

B. ANTICIPATION AND OBVIOUSNESS REJECTIONS

The examiner asserts, "Barrett discloses at column 7, lines 53-55, that 'the date and time' is directly related to the time stamp to determine the recency to assign priority based on the time of day (date)." (Examiner's Answer at 4.) He adds, "[f]urthermore, Barrett discloses in figure 6 a menu having a URL list displaying a plurality of URLs, and at least some URLs in the list are arranged based on which have been time stamped recently." (*Id.*) The examiner further asserts, "Barrett discloses 'the profile' will contain history of past URLs, and calculating statistics based on date and time (col. 7 lines 35-67), and the 'Instance Hot List' which includes a ranking weighted by time proximity of frequency and recency (col. 9 lines 1-8 and col. 10 lines 53-67)." (*Id.*) Explaining that his "invention considers time of day (e.g., 11 AM, 3 PM, or 7 AM) and ranks URLs accordingly," (Reply Br. at 3), the appellant argues, "[t]he Barrett mechanism, on the other hand, does not account for the fact that it is morning, noon, or night, but instead looks at the most recently accessed URLs and ranks them accordingly." (*Id.*)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe claims at issue to determine their scope. Second, we determine whether the construed claims are anticipated or would have been obvious.

1. Claim Construction

"Analysis begins with a key legal question -- *what* is the invention *claimed*?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "[c]laims are not interpreted in a vacuum, but are part of and are read in light of the specification." *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116, 1 USPQ2d 1563, 1566 (Fed. Cir. 1987) (citing *Hybritech Inc. v. Monoclonal Anti-bodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94-95 (Fed. Cir. 1986); *In re Mattison*, 509 F.2d 563, 565, 184 USPQ 484, 486 (CCPA 1975)).

Here, claim 7 recites in pertinent part the following limitations: "a menu for presentation by said program, said menu having a Uniform Resource Locator (URL) list containing a plurality of URLs, at least some URLs in said list being arranged based at least in part upon time of day." Claims 13 and 15 recite similar limitations. **The appellant's specification distinguishes "time of day" from "frequency of selection [and] recency of selection."** (Spec. at 4, 25-28.) More specifically, the specification supports the appellant's assertion that "[t]he phrase *time of day* is well understood to refer to a particular time during the day." (Reply Br. at 3.) Reading the limitations in light of the specification, claims 7, 13, and 15 require arranging URLs into a list based at least in part upon a particular time during the day.

2. Anticipation and Obviousness Determinations

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (citing *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 715, 223 USPQ 1264, 1270 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.,* 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

Here, Barrett discloses "[a] system . . . for use with . . . the Internet World Wide Web . . . for assisting a user in accessing information stored at remote network sites based on the user's past history of network usage." Abs., ll. 1-5. Although the first passage of the reference cited by the examiner mentions a "date and time," col. 7, l. 53, the date and time relate to recency of selection rather than to time-of-day. Specifically, "the date and time of the prior downloads, or some suitable **indication of how recently**

each download took place, is also obtained, and used later." Col. 7, ll. 51-56 (emphasis added.)

Figure 6 of Barrett, which the examiner also cites, depicts "a simplified example of a user interface showing information displayed in accordance with the invention. . . ." Col. 6, ll. 10-11. Although the user interface displays a list of URLs, we see no evidence therein that the URLs are arranged based at least in part upon a particular time during the day. To the contrary, the URLs are arranged "based on the decreasing number of past occurrences." Col. 8, l. 61.

For its part, the second-to-last passage cited by the examiner identifies Web pages based on frequency of selection or recency of selection rather than on time-of-day. Specifically, "a Web page likely to be selected is identified. This may be done by taking the **most frequently occurring** page, or by other suitable means such as weighting past occurrences according to **how recently they took place**." Col. 7, ll. 5-8 (emphases added).

The last passage cited by the examiner describes "an 'Instant Hot List.'" Col. 10, ll. 54-55. "This is a list of previously visited pages, comparable to the conventional 'hot list' such as IBM's Quick List, but which includes a ranking based on a suitable factor,

such as numbers of previous visitations, or visitations weighted by time proximity." *Id.* at ll. 55-59. We find that the "number of previous" visitations relates to frequency of selection rather than time of day. Unsure to what the "time proximity" refers, we will not engage "speculations and assumptions," *in re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962), in interpreting the reference. The absence of arranging URLs into a list based at least in part upon a particular time during the day negates anticipation. Therefore, we reverse the anticipation rejection of claims 7, 13, and 15.

"In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "'A *prima facie* case of obviousness is established when the teachings from the prior art itself would . . . have suggested the claimed subject matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, the examiner does not allege, let alone show, that the addition of Brown cures the aforementioned deficiency of Barrett. Absent a teaching or suggestion of arranging URLs into a list based at least in part upon a particular time during the day,

we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejection of claims 10-12, 21 and 22, and 18-20; which respectively depend from claims 7, 13, and 15.

CONCLUSION

In summary, the rejection of claims 1-6 under § 101 is reversed. The rejection of claims 7, 13, and 15 under § 102(e) and the rejection of claims 10-12 and 18-22 under § 103(a) are also reversed.

REVERSED

JAMES D. THOMAS Administrative Patent Judge	)
JOSEPH F. RUGGIERO Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)

IBM Corporation
Intellectual Property Law, Dept. 917
3605 Highway 52 North
Rochester, MN 55901-7829